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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte NIZAR YOUSSEF MEHIO

Appeal 2009-014050
Application 10/751,119
Technology Center 1700

Decided: May 27, 2010

Before CATHERINE Q. TIMM, BEVERLY A. FRANKLIN, and
LINDA M. GAUDETTE, *Administrative Patent Judges*.

TIMM, *Administrative Patent Judge*.

DECISION ON APPEAL

I. STATEMENT OF CASE

Appellant appeals under 35 U.S.C. § 134 from the Examiner's decision to reject claims 24, 25, 27-40, and 43-45. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM-IN-PART.

Appellant's invention relates to a smoking pipe (hookah), which may be dismantled for repair, replacement, and maintenance and which has a stem fastened securely when assembled (Spec. ¶¶ [0001] and [0014]).

Claims 36 and 40 are illustrative:

36. A modular hookah comprising:

a threaded burner for accepting dry smoke,

a threaded intermediate tube, releasably attached in gaseous communication with said threaded burner;

a threaded plenum, releasably attached in gaseous communication with said threaded intermediate tube, defining a wet smoke aperture for releasing wetted smoke to a user and further having a down tube for releasing dry smoke; and

a threaded base, releasably attached in gaseous communication with said plenum, dimensioned to contain a substantial amount of fluid for receiving and wetting dry smoke.

40. A modular hookah comprising:

a base with a threaded connection for receiving dry smoke and dimensioned to contain a substantial amount of fluid;

an intermediate tube with a threaded connection;

a threaded plenum, releasably attached in gaseous communication with said intermediate tube, having a down tube for releasing dry smoke into said base; and

wet smoke conducting means, disposed within said plenum and in gaseous communication with said base, for accepting and conducting wet smoke from said base.

The Examiner relies upon the following evidence:

<u>First Named Inventor</u>	<u>Document No.</u>	<u>Issue or Pub. Date</u>
Ganim	US 722,405	Mar. 10, 1903
Zahariadis	US 1,513,147	Oct. 28, 1924
Rohlfing	US 3,451,785	Jun. 24, 1969
Kahler	US 3,872,872	Mar. 25, 1975

The Examiner maintains the following rejections:

1. The rejection of claims 24, 40, and 43-45 under 35 U.S.C. § 102(b) as anticipated by Zahariadis;
2. The rejection of claims 25, 27-30, and 31-33 under 35 U.S.C. § 103(a) as unpatentable over Zahariadis in view of official notice;
3. The rejection of claims 36-38 under 35 U.S.C. § 103(a) as unpatentable over Ganim in view of Kahler and Rohlfing; and
4. The rejection of claims 34, 35, and 39 under 35 U.S.C. § 103(a) as unpatentable over Zahariadis in view of Ganim and Kahler.

Appellant seeks review of the rejections of claims 27-40 and 43-45 (Br. 5).¹

¹ Appellant asserts that claims 24 and 25 are not on appeal (Br. 5). Accordingly, the appeal is dismissed as to claims 24 and 25. *See Ex parte Ghuman*, 88 USPQ2d 1478 (BPAI 2008). The Examiner is instructed to cancel claims 24 and 25 and to require the limitations of claims 24 and 25 to be incorporated into claim 27. Likewise, dependent claim 34 should be amended to contain all of the elements of claim 24. Appellant groups dependent claim 34 with claim 27, though claim 34 does not depend from claim 27 and does not include the limitations recited in claim 27 on which Appellant argues patentability (Br. 11). Appellant also groups dependent claim 39 with independent claim 36 (*id.*). However, claim 39 depends from claims 34 and 24, and not from independent claim 36. Since these groupings do not match with their dependency, and since claims 34 and 39 are not separately argued, we summarily affirm the Examiner's rejections of claims 34 and 39.

II. DISCUSSION

A first issue on appeal arising from the contentions of Appellant and the Examiner is: does the evidence support the Appellant's view that the Examiner erred in finding element 5 of Zahariadis constitutes a "plenum," as recited in claim 27?

A second issue on appeal arising from the contentions of Appellant and the Examiner is: does the evidence support the Appellant's view that the Examiner erred in finding that (a) element P of Ganim constitutes a "burner," (b) element F of Ganim constitutes an "intermediate tube," and (c) element D of Ganim constitutes a "plenum," as recited in claim 36?

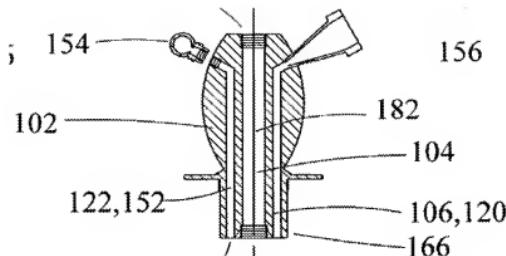
A third issue on appeal arising from the contentions of Appellant and the Examiner is: does the evidence support the Appellant's view that the Examiner erred in finding that element 3 of Zahariadis constitutes a "plenum" and element 6 of Zahariadis constitutes a "intermediate tube," as recited in claim 40?

Except for those findings that we expressly overturn or set aside below, we adopt the Examiner's findings in the Answer as our own. Additional findings of fact may also appear below.

During examination, "claims . . . are to be given their broadest reasonable interpretation consistent with the specification, and . . . claim language should be read in light of the specification as it would be interpreted by one of ordinary skill in the art." *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004) (quoting *In re Bond*, 910 F.2d 831, 833 (Fed. Cir. 1990)).

Turning first to claim 27, we note that this claim requires a “plenum further defining said dry smoke aperture and defining said wet smoke aperture, said plenum having an upper end adapted to removably fasten to said lower end of said intermediate tube.” The Examiner interprets the term “plenum” to mean “a space filled with matter as opposed to a vacuum” (Ans. 6). Appellant interprets the term as meaning “an air-filled space in a structure; especially: one that receives air from a blower for distribution” (Br. 13). While we agree that the common definition of the term “plenum” is an open space, a meaning that refers only to open space and not to a particular structure defining a space would be entirely inconsistent with Appellant’s Specification as it would be interpreted by one of ordinary skill in the art.

We must consider the meaning of the term plenum as it is used in Appellant’s Specification. *See In re Fout*, 675 F.2d 297, 300 (CCPA 1982) (“Claims must always be read in light of the specification.”). Appellant’s Specification refers to reference numeral 102 in Figures 1 and 2 as a “plenum” having apertures (Spec. ¶ [0015]). Appellant’s Specification also describes a plenum having external threads 132 disposed substantially helically around a lower end and being inserted into base 114 (Spec. ¶ [0020] and [0023]; Fig. 5). Reference numeral 102 refers to the structure represented below, which includes a dry smoke aperture 104 defined along an axis 182, a wet smoke aperture 106/conduit 120 and a pressure relief aperture 152/second conduit 122 (Spec. ¶ [0015], [0025], [0035]). A portion of Figure 2 is reproduced below:



The reproduced portion of Figure 2 is an exploded, cut away view of a portion of the modular smoking apparatus (Spec. ¶ [0013]).

Figure 2 and the associated descriptions of a “plenum” in Appellant’s Specification shows that a plenum is a structure, and not an open space. The structure defines conduits (i.e., apertures) therein. The term “plenum” is consistently used to refer to a structure through out the Specification (see plenum 202 in Figures 3 and 4; Spec. [0032]).

We also consider the context of the claim in which the term is used. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1314, (Fed. Cir. 2005) (“To begin with, the context in which a term is used in the asserted claim can be highly instructive.”). Here the term is described in claim 27 as “defining said dry smoke aperture and defining said wet smoke aperture” and “having an upper end adapted to be removably fastened to said lower end of said intermediate tube” (claim 27). An open space is not capable of having these structural features.

Accordingly, the Examiner’s finding that the open space encompassed by element 5 in Zahariadis constitutes a plenum as claimed, is not supported by the even the broadest meaning one of ordinary skill in the art would

provide the structure based on Appellant's Specification. Thus, we cannot sustain the Examiner's rejection of claim 27.

Turning to claim 36, Appellant first contends that element P of Ganim is a tobacco bowl and not a "burner," and that, rather, element F properly constitutes a "burner" within the meaning provided in Appellant's Specification. Thus, according to Appellant, the apparatus of Ganim lacks a stem comprising both an intermediate tube and a plenum (Br. 16; Reply Br. 5). We disagree.

Other than the representation of a burner in the Figures, Appellant's Specification is entirely silent as to any particular structure required for the burner. The only discussion of the burner is that it has a lower end into which an upper end of intermediate tube may be inserted (Spec. ¶ [0018]), the structure of which is met by the teaching of Ganim as relied upon by the Examiner. While Figure 2 of Appellant's Specification depicts a burner without any means for holding tobacco, we find that the scope of the term "burner" in claim 36 does not preclude the presence of a bowl for such a purpose. Since Ganim teaches that tobacco is lighted in the bowl of element P and that smoke passes through passages in element P (Ganim, col. 2, ll. 46-50 and 62-63), we agree with the Examiner's finding that the term "burner" in claim 36 reads on element P of Ganim.

Similarly, other than the representation of an intermediate tube in the Figures, Appellant's Specification is entirely silent as to any particular structure required for the intermediate tube other than its disposition between the burner and the plenum and the presence of external threads connecting the pieces (Spec. ¶¶ [0017] and [0018]). Accordingly, we agree

with the Examiner's finding that an intermediate tube reads on crown F of Ganim, with the obvious modifications of the appropriate threading.

Appellant also contends that element D is not a plenum, within the meaning of claim 36, as it is not in gaseous communication with the intermediate tube and cannot release dry smoke to the base, since the dry smoke is wholly contained by tube H (Br. 17-18; Reply Br. 5-6). The Examiner responds that element D "and all the space within D is capable of transporting dry smoke (portion of tube H within D) and wet smoke in the area referenced I" (Ans. 13). In other words, the Examiner is considering the portion of tube H that exists within element D as part of the plenum. Appellant points us to no error in this finding. Moreover, claim 36 does not require a down tube as an element separate and apart from the recited plenum. The presence of tube H within element D (*see* Ganim, Figure 2) means that the structure of Ganim meets the requirement of claim 36 of a plenum "having a down tube for releasing dry smoke." Moreover, claim 36 requires that the plenum be in gaseous communication with the intermediate tube, but not in *direct* gaseous communication (claim 36). We find that Ganim teaches element D is in gaseous communication with element F via the down tube H.

Since the Examiner's obviousness rationale is that one of ordinary skill in the art would have used the appropriate male/female threaded connections to connect the elements disclosed by Ganim, which Appellant does not contest, we find that the Examiner did not err in concluding that claim 36 would have been obvious to one of ordinary skill in the art.

Turning to claim 40, Appellant first contends that element 3 of Zahariadis is a tobacco bowl and not an intermediate tube, within the meaning provided in Appellant's Specification, and thus the apparatus of Zahariadis lacks a stem comprising both an intermediate tube and a plenum (Br. 22). We disagree. As discussed above, other than the representation of an intermediate tube in the Figures, Appellant's Specification is entirely silent as to any particular structure required for the intermediate tube other than its disposition between the burner and the plenum and the presence of external threads connecting the pieces (Spec. ¶¶ [0017] and [0018]), the structure of which is met by element 3 of Zahariadis as relied upon by the Examiner. Thus, we agree with the Examiner's finding that the term "intermediate tube" in claim 40 reads on the element 3 of Zahariadis.

Appellant's further arguments are directed to element 18 of Zahariadis (Br. 23), which the Examiner erroneously identified as corresponding to the recited "plenum" in the Final Office Action rather than element 6 of Zahariadis (Ans. 15). Appellant's Reply Brief provided a full opportunity for Appellant to respond to the stated correction in the Examiner's Answer. However, Appellant instead relies on the prior arguments in the Brief directed to element 18 and urges the entering of a new ground of rejection (Reply Br. 7). Accordingly, Appellant has not persuaded us as to any error in the Examiner's corrected finding.

Appellant's remaining arguments are directed to the Examiner's failure to enter the proposed Amendment of August 15, 2007. Decisions within the Examiner's discretion, such as whether or not to enter an amendment after final rejection, are reviewed only by way of petition, not

appeal. *See In re Berger*, 279 F.3d 975, 984-85 (Fed. Cir. 2002) (Examiner's refusal to enter amendment after final may be the subject of a petition, but may not be reviewed by the Board); 37 C.F.R. § 1.127 ("From the refusal of the primary examiner to admit an amendment, in whole or in part, a petition will lie to the Director under § 1.181.").

III. CONCLUSION

On the record before us² and for the reasons discussed above, we summarize our conclusions as follows:

1. We dismiss the appeal with respect to claims 24 and 25;
2. We sustain the rejection of claims 40 and 43-45 under 35 U.S.C. § 102(b) as anticipated by Zahariadis;
3. We do not sustain the rejection of claims 27-30 and 31-33 under 35 U.S.C. § 103(a) as unpatentable over Zahariadis in view of official notice;
4. We sustain the rejection of claims 36-38 under 35 U.S.C. § 103(a) as unpatentable over Ganim in view of Kahler and Rohlffing; and
5. We sustain the rejection of claims 34 and 39, but do not sustain the rejection of claim 35, under 35 U.S.C. § 103(a) as unpatentable over Zahariadis in view of Ganim and Kahler.

IV. DECISION

We affirm-in-part the Examiner's decision.

² Only those arguments actually made by Appellant have been considered in this decision. Arguments which Appellant could have made but chose not to make have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii) (2008).

V. TIME PERIOD FOR RESPONSE

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED-IN-PART

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